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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/472,762
Filing Date: December 27, 1999
Appellant(s): HAUSER, CARL H.

Daniel Curtis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/7/2005 appealing from the Office action mailed

6/9/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,721,910	Unger et al	2-1998
5,107,419	MacPhail	4-1992
6,418,457	Schmidt et al	7-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1, 3, 5, 9-10, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated

by Unger et al (hereinafter Unger), US Patent 5,721,910.

2.   As per claims 1, 3 and 5, Unger taught the invention as claimed including a computer-

implemented method/computer program product having a computer-readable medium holding

computer-executable instructions for performing a method for adding a document to a plurality

of stored documents, comprising:

        a. loading the document into storage, said loaded document having a document

           category (col.2, lines 58-65);

        b. determining the document category of said loaded document (col.3, lines 9-15);

        c. extracting information from said loaded document indicating at least one of a

           document data, a document transaction type and a document identifier (col.1,

           lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10,

           lines 34-65); and

        d. applying to said loaded document at least one document handling procedure

           associated with the document category of said loaded document (col.3, lines 22-

           28, col.4, lines 44-57, col.7, lines 40-46): said document handling procedure

           linking said loaded document to at least one of said plurality of stored documents

           using the at least one of the document date, the document transaction type and the

document identifier extracted from said loaded document (col.4, lines 44-57,

col.5, lines 17-35, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-67,

col.9, lines 1-4, 54-60, col.10, lines 34-65).

3.   As per claim 9, Unger taught the invention as claimed in claim 1. Unger further taught

that the loaded document further includes document format data specifying whether the loaded

document is an electronic document or a document image (col.3, lines 66-67, col.4, lines 1-7).

4.   As per claims 10, 13 and 16, Unger taught the invention as claimed in claims 1, 3 and 5.

Unger further taught that the document category of the loaded document is determined by data

content extracted form the loaded document and matched to pre-determined set of document

categories (col.1, lines 21-24, 40-43, col.3, lines 9-15, col.4, lines 44-57, col.6, lines 48-51, col.7,

lines 55-65, col.8, lines 52-67).

5.   Claims 7, 11, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Unger et al (hereinafter Unger), US Patent 5,721,910, in view of Official Notice.

6.   As per claim 7, Unger taught the invention substantially as claimed including a method

comprising:

      a.   Accessing, on the one or more first computers, computer-executable instructions

         for adding a document to a plurality of stored document (col.2, lines 58-63,

col.13, lines 2-15): the computer-executable instructions when executed by a

computer, performing the steps of:

i. loading the document into storage, said loaded document having a

document category (col.2, lines 58-65);

ii. determining the document category of the loaded document (col.3, lines 9-

15);

iii. extracting information from said loaded document indicating at least one

of a document data, a document transaction type and a document identifier

(col.1, lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines

52-62, col.10, lines 34-65); and

iv. applying to the loaded document a document handling procedure

associated with the document category (col.3, lines 22-28, col.4, lines 44-

57, col.7, lines 40-46), said document handling procedure linking said

loaded document to at least one other of said plurality of personal

documents using the at least one of the document data, the document

transaction type and the document identifier extracted from said loaded

document (col.4, lines 44-57, col.5, lines 17-35, col.6, lines 48-51, col.7,

lines 26-51, 55-65, col.8, lines 52-67, col.9, lines 1-4, 54-60, col.10, lines

34-65).

7. Unger did not specifically teach the system to transfer the computer-executable

instructions from the one or more first computers to the second computer connected to the one or

more first computer through a communications medium. However, Unger taught that the

method can be implemented in a computer system (col.4, lines 33-43) and that the documents

may be on a CD-ROM, in a database, a LAN/WAN or on the Internet (col.1, lines 49-54, col.6,

lines 51-55). Furthermore, Unger taught to search for documents and electronically store the

results in tables (col.5, lines 56-66) wherein the documents may be stored remotely over the

Internet (col.1, lines 49-54, col.6, lines 51-55). Official Notice is taken that both the concept and

advantage of transferring computer-executable instruction from one computer to another is well

known and expected in the art. It would have been obvious to one of ordinary skill in the art to

transfer data files or executable instruction from one computer to another through a medium in a

computer system especially in obtaining/requesting data files in LAN/WAN or Internet networks

from remote databases. One would have been motivated to send a requesting/searching

instruction to a remote computer containing databases to obtain the desired documents from the

database. It would have been obvious to one of ordinary skill in the art at the time the invention

was made to allow users to transfer the computer-executable instruction contained in Unger's

system from one computer to another through a communication medium for sharing purposes.

8.   As per claims 11, 14 and 17, Unger taught the invention substantially as claimed in

claims 1, 3 and 5. Unger did not specifically teach that the document category is determined by

a pre-determined category input with the loaded document. However, Official Notice is taken

that it would have been obvious to manually assign the document category when loading the

document. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to manually input the document category to the loaded documents.

9.   Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Unger et al (hereinafter Unger), U.S. Patent 5,721,910, in view of MacPhail, U.S. Patent

5,107,419.

10.   As per claims 2, 4, 6 and 8, Unger taught the invention substantially as claimed in claims

1, 3, 5 and 7. Unger did not specifically teach the document handling procedure to include

retention criteria for determining how long to save the loaded document. MacPhail taught a

document classification system to have the document handling procedure to include retention

criteria for determining how long to save the document (col.1, lines 59-63, col.3, lines 6-9, 19-

21, 26-33). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Unger and MacPhail because MacPhail's

teaching of using retention criteria to determine whether the documents stored in the document

storage exceeds expiration date can help the processing rule in Unger's system to automatically

delete the to documents that are no longer needed to save system storing space (col.1, lines 59-

63).

11.   Claims 12, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Unger et al (hereinafter Unger), U.S. Patent 5,721,910, in view of Schmidt et al (hereinafter

Schmidt), U.S. Patent 6,418,457.

12.   As per claim 12, 15 and 18, Unger taught the invention substantially as claimed in claims

1, 3 and 5. Unger further taught to extract a document identifier (col.1, lines 21-24, col.6, lines

48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10, lines 34-65; patent's unique

identifier). Unger did not specifically teach that the document identifier indicating an account

number and a transaction date; and wherein the document handling procedure links the loaded

document to a set of stored documents having the account number; the document handling

procedure further ordering the loaded document among the set of stored documents by the

transaction date. Schmidt taught to use the document identifier to indicate an account number

and a transaction date; and wherein the document handling procedure links the loaded document

to a set of stored documents having the account number; the document handling procedure

further ordering the loaded document among the set of stored documents by the transaction date

(col.5, lines 23-37, 41-43, 55-56, 65-67, col.6, lines 1-27, 33-38, 43-48, 54-65). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Unger and Schmidt because Schmidt's teaching of providing documents related to

the loaded document using the identifier of the loaded document enables Unger's method to

bring up the full history of the loaded document including the previous revisions (col.5, lines 65-

67, col.6, lines 1-27).

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies

individually.

As per appellant's argument that:

(1) The Unger reference teaches the "determining the document category" element of claim 1 through the use of "expert technical searches." Examiner relied upon column 3, lines 9-15 in rejecting "determining the document category of the loaded document" where the "pre-determined search strategies" in column 3, lines 9-15 is the ETS discussed elsewhere in the Unger reference (ETS is shown in stage IV). Examiner must provide a showing of teachings in Unger that discloses the applying step and all of its limitation occurring after the database in Unger is populated by the ETS because the applying step uses data generated from the determining and extracting steps.

In reply to argument (1), appellant's allege that the determining step must be preceding the extracting and applying step because the applying step uses data generated from the determining and extracting step is only true if the document does not already have a defined document category. Appellant failed to defined in the claims that the document categories are defined after the documents are loaded to the database. Unger taught that the documents, which are loaded into the database, are technical documents such as patent, business or scientific publication (col.2, lines 58-65). These documents each are given (possibly manually) a pre-defined document category prior to they are loaded into the database (e.g. Patent or Non-Patent, Science or Business). Loading documents that have pre-defined document categories reads clearly on the claim language of "*loading the document into storage, said loaded document having a document category*" in claims 1, 5 and 7. Once the documents are loaded to the database, these pre-defined document categories may be determined by the computer-implemented method at any time once the documents are loaded. For example, the document

category of a patent may be determined when the patent class of the patent document is extracted

in the extracting step (col.1, lines 21-24, col.7, lines 43-46, col.10, lines 34-65; Stage III; parsing

of the data fields including document identifier such as patent number). Therefore, the step of

determining does not necessary have to occur prior to the steps of extracting and applying.

(2) The Unger reference does not teach or disclose the "applying" step. Document

handling procedure performed by a human is not an appropriate teaching for an element in the

computer-implemented method of claim 1.

In reply to argument (2), having the fact that the loaded documents each are having a

pre-defined category (see reply to argument (1)), the step of applying does not necessary has to

occur after the step of determining. Unger taught in column 5, lines 17-35 to capture documents

(patent) and parsing the data fields such as document identifier, document type (patent numbers,

abstract, inventor, assignee, publication date...etc), then electronically linking the captured

information to one particular patent family and displayed (col.5, lines 16-36). Where capturing,

linking and displaying of the documents are all computer-implemented document handling

procedures. Unger taught to capture of documents in Stage III through VI

   a. loading the document into storage, said loaded document having a document

      category; (col.2, lines 58-65; Stages I-II; a database system for storing documents

      where the documents each having themselves a category such as patents, patent

      class, technical documents, business documents, scientific specialties or document

      types; col.5, lines 3-15)

   b. determining the document category of said loaded document (col.3, lines 9-15);

   c. extracting information from said loaded document indicating at least one of a
       document date, a document transaction type and a document identifier (col.1,
       lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10,
       lines 34-65; Stage III; parsing of the data fields including document identifier
       such as patent number); and

   d. applying to said loaded document at least one document handling procedure
       associated with the document category of said loaded document (col.3, lines 22-
       28, col.4, lines 44-57, col.7, lines 40-46; Stage III-IV; capturing the loaded
       document and models into categories): said document handling procedure (e.g.
       capturing document) linking said loaded document to at least one of said plurality
       of stored documents (linking patent family) using the at least one of the document
       date, the document transaction type and the document identifier extracted from
       said loaded document (using patent number as the document identifier) (col.4,
       lines 44-57, col.5, lines 17-35, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8,
       lines 52-67, col.9, lines 1-4, 54-60, col.10, lines 34-65).

Unger reference taught a database system for storing documents where the documents

each having themselves a pre-defined category such as patents, technical documents, business

documents, scientific specialties or document types (i.e. loading the document into storage, said

loaded document having a document category; col.2, lines 58-65) where the database use

predefined search strategies to automatically categorize the documents (i.e. determining the

document category of said loaded document; col.3, lines 9-18) and that the categorization may be

used by the relational database to identify trends and discontinuities in the research efforts

represented by the technology in the underlying technical documents and/or patent (i.e.

document handling procedure associated with the document category of the loaded document;

col.3, lines 22-25). Since the appellants fail to define the functionality of "*document handling*

procedure" in the claims, appellant's argument that col.3, lines 22-25 of Unger does not teach

"the document handling procedure is associated with the category determined in the earlier

determining step" is incorrect. Unger further disclose in detail that the documents stored in the

relational database, of column 3, lines 22-25, are **linked to** the categorization which reflects the

overall hierarchical model (the process of storing a loaded document in database is inherently "a

computer-implemented document handling procedure"; see col.3, lines 46-49) and that the

documents may be displayed on a computerized graphical interface in categories or subsets of

categories (the process of document displaying is yet another limitation which reads on a

computer-implemented "document handling procedure"; Unger also taught to display the

documents in categories or subsets of categories; col.3, lines 49-55). These processes (storing a

loaded document or displaying document) evidently showed the claimed limitation of "*applying*

to said loaded document at least one document handling procedure associated with the

document category of said loaded document". Unger further taught that the relational database

also contain subject-specific tables to link similar documents together using original

classification (grouping shows another computer-implemented document handling procedure;

see col.4, lines 44-54), which may then be evaluated by an individual (however, allowing a

human to evaluate the grouping after the original classification does not render the initial

classification to be non-computer implemented).

(3) Claims 11, 14 and 17, Unger teaches away from the manual assignment of the

document category to the document by the use of the expert technical searches which

automatically categorize the documents in the database taught in Unger. Hence, the Official

Notice taken by the examiner fails to state the motivation or suggestion for altering the process in

Unger from automatically categorizing the documents.

In reply to argument (3), Unger taught that the loaded documents to have pre-determined

category such as patent or technical papers. Unger did not specifically teach that the document

category is determined by a pre-determined category <u>input with the loaded document</u> (The claim

language is interpreted as "document category defined while loading the document" by the

examiner). Unger does not teach away from the manual assignment of the document category.

The documents such as patents contain pre-defined document types (category) prior to they are

loaded. Manual assignment of the document category to define these document types such as

scientific or business technical publications may be done while documents are loaded to the

database. It would have been obvious to manual assign non-patent documents categories while

they are being loaded (e.g. classifying a patent application before it is scanned). This does not

affect Unger's teaching of automatic document categorizing of the database after the documents

are loaded (col.3, lines 9-15).

(4) Appellant stated that Unger appears to teach away from establishing any sort of

retention scheme for the records in the technical database and cited the abstract, column 4, lines

32-37 and column 6, lines 24-33 of Unger in support the statement that Unger is not suitable for

the retention method disclosed in MacPhail.

In reply to argument (4), management to a database is always needed. Although Unger

taught that the database system allows patents and/or technical documents to be electronically

captured and analyzed at a convenient time...the stored analysis may be used minutes, days,

months or years later, it does not exclude management possibilities from the database. Nowhere

in Unger disclosed that the loaded documents and the database could not be changed or removed.

Certain documents, which are not needed or contain errors, should be removed or edited from the

database. For example, it is well known that many technical publications are licensed. These

licensed publications may expire unless a fee is constantly charged from the user/company. It

would have been obvious that the usage of technical documents may expire after a period of time

due to licensing agreement (expiration of ownership). Also, it is possible that a particular

document is loaded to the database more than once by mistake, or that a second version of the

same technical document is published to correct the errors in the previous version. These

duplicated or outdated documents take up valuable database space if not removed. Even worse,

the loaded documents with errors yield faulty analysis if not removed. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Unger and MacPhail because MacPhail's teaching of using retention criteria to

determine whether the documents stored in the document storage exceeds expiration date can

help the processing rule in Unger's system to automatically delete the to documents that are no

longer needed to save system storing space (see MacPhail, col.1, lines 59-63). MacPhail's

teaching of using retention is established by the author/user who files the document to the system

(col.3, lines 18-34; when a document is to be filed to the system, the retention and deletion

selection criteria must be entered into the system and stored in the system at the same time as the

document). Where in Unger's method, are the users who load the documents by the use of ETS

(technical experts), not the users who access the database. Hence, appellant's argument that "it

would seem unreasonable to allow any one user control over when to delete a document..." if

Unger reference is combined with MacPhail is incorrect since only the administrator or the users

(technical experts) who file the document to the system can set to time to retain the document

and that the document that expires the time of retention is deleted when it is not needed, not by

the control of other users.

(5) Unger's documents in the database are not suitable for the document handling method

disclosed in Schmidt.

In reply to argument (5), it is well known in that patent applicant may include history

data such as related parent applications, non-provisional, provisional application and copending

applications. As for technical documents, a revision may be published in order to correct errors

in the previous version. Schmidt taught to use the document identifier to indicate an account

number and a transaction date; and wherein the document handling procedure links the loaded

document to a set of stored documents having the account number; the document handling

procedure further ordering the loaded document among the set of stored documents by the

transaction date (col.5, lines 23-37, 41-43, 55-56, 65-67, col.6, lines 1-27, 33-38, 43-48, 54-65)

where the patent application's full history such as revisions (amendments), office action,

responses...etc. may be grouped together (col.5, lines 65-67, col.6, lines 1-27). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Unger and Schmidt because Schmidt's teaching of providing documents related to

the loaded document using the identifier of the loaded document (e.g. patent number of the

patent) enables Unger's method to bring up the full history (patent family including related

parents applications) of the loaded document including the previous revisions (see Schmidt,

col.5, lines 65-67, col.6, lines 1-27).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Conferees:

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